

SBJ MARIKINA SHOE EXCHANGE CORP.,
Opposer,

-versus-

NORTH ROCK ASSOCIATES LTD.,
Respondent- Applicant.

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IPC No. 14-2014-00287
Opposition to:
Appln. Serial No. 4-2013-002046
Date Filed: 22 February 2013
TM: "EPIC MMA CLUB"

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NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 34 dated February 09, 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, February 10, 2017.


MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

SBJ MARIKINA EXCHANGE CORP.,
Opposer,

-versus-

NORTH BLOCK ASSOCIATES LTD.,
Respondent-Applicant.

X ----- X

IPC No. 14-2014-00287
Opposition to Trademark
Application No. 4-2013-002046
Date Filed: 22 February 2013

Trademark: **"EPIC MMA CLUB"**

Decision No. 2017- 34

DECISION

SBJ Marikina Exchange Corporation¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-002046. The contested application, filed by Emmanuel North Block Associates Ltd.² ("Respondent-Applicant"), covers the mark "EPIC MMA CLUB" for use on *"clothing, headgear, footwear, belts (clothing), exercise wear, sports wear, stockings, tights and hosiery, bathing suits, beachwear, gloves and mittens, socks, scarves and neckties, robes and gowns, head bands and wrist bands, leotards, leg warmers, and yoga wear"* and *"entertainment, education and training services; arranging and conducting classes, seminars, conferences, conventions, exhibitions and instructor training in the fields of martial arts, physical fitness, yoga, meditation, sports, mental training and discipline, and health, and distributing course materials in connection therewith; organizing sporting and cultural activities; ticket reservation services (entertainment); entertainment information services; provision of club recreation facilities, provision of club sporting facilities, provision of gymnasium facilities, organizing of sport events and sport competitions, health club services, provision of sport facilities and keep-fit facilities, leisure centre services, provision of physical education facilities; providing information relating to martial arts, physical fitness, yoga, mediation, sports, mental training and discipline, entertainment and education; editorial and publication services of books, magazines, leaflets and printed matter relating to martial arts, physical fitness, yoga, mediation, sports, mental training and discipline, entertainment and education; provision of the foregoing information, entertainment and recreational services by electronic means; distribution and production of films, video discs, video tapes, audio tapes, compact discs, laser discs; production of radio and television programs; provision of information, consultancy services and advisory services relating to all the aforesaid services"* under Classes 25 and 41, respectively, of the International Classification of Goods³.

¹ A corporation organized and existing under the laws of the Republic of the Philippines with office address at No. 1610 A. Rodriguez Ave., Brgy. Dela Paz, Pasig City.

² A foreign limited company with known address at Akara Building, 24 De Castro Street, Wickhams Cay 1, Road Town, Tortola, Virgin Islands.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization.

The Opposer alleges, among others, that it is a direct-selling company incorporated in 1999 and has long been engaged in the distribution of shoes, apparel, accessories, home care and personal care products through its network of dealers. Its products are now available in Hong Kong, Malaysia, Brunei and the Middle East. In order to sell its products, it publishes catalogues every other month under its house mark "MSE". For its catalogues, advertisements and promotions, it engages services of showbiz personalities, including Iya Villania, Vhong Navarro, Carla Abellana and Billy Crawford. It also promotes and advertises its products in its website www.mse.com.ph. It has allegedly spent huge amounts in the development of the products sold in the market.

The Opposer claims to be the prior user of the mark "EPIC" covered by Certificate of Registration No. 4-2013-503697 for goods under Classes 16, 18 and 25. The said mark was transferred to it as shown in the Deed of Assignment dated 21 January 2014. In support of their Opposition, the Opposer submitted the following:⁴

1. samples of MSE catalogues;
2. photographs of its products, tags and labels;
3. copy of Registration No. 4-2013-503697;
4. copy of the Deed of Assignment dated 21 January 2014; and,
5. comparison of the competing marks.

A Notice to Answer was issued and served upon the Respondent-Applicant on 23 October 2014. The latter, however, did not file an Answer. Thus, the Adjudication Officer issued Order No. 2015-222 on 02 February 2015 declaring the Respondent-Applicant in default. After which, the case is submitted for decision.

The issue to be resolved in this case is whether the Respondent-Applicant's trademark application for "EPIC MMA CLUB" should be allowed.

Section 123.1 (d) of RA 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

"123.1. A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

(i) The same goods or services, or

(ii) Closely related goods or services, or

The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

⁴ Marked as Exhibits "B" to "E", inclusive.

(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

xxx."

Records reveal that at the time the Respondent-Applicant filed its application for registration of the contested mark on 22 February 2013, the Opposer has already registered the mark "EPIC" under Certificate of Registration No. 4-2013-503697 issued on 13 March 2014.

But are the marks, as shown below, confusingly similar?



Opposer's Marks



Respondent-Applicant's Mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The only similarity in the competing marks is the use of the word "EPIC". This, notwithstanding, the marks are distinguishable. The Opposer's mark is comprised of white lines forming the word "EPIC" cast in a black background. On the other hand, the Respondent-Applicant's mark consists of the word "EPIC" in red letters, the upper end of the "E" of which forms a head of a dragon. The said word is placed between two horizontal lines with the words "MMA CLUB" at the bottom.

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

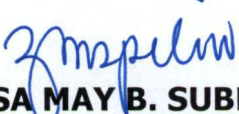
Moreover, the Trademark Registry, which this Adjudication Officer may take judicial notice, shows that there are other registered trademarks that appropriate the "EPIC" for similar and/or related goods such as "EPIC THREADS" under Certificate of Registration No. 4-2015-014506 and "THE EPIC HOLLISTER STORE" under Certificate of Registration No. 4-2009-008146. Noteworthy, the Trademark Registry also reveals that the Respondent-Applicant itself has an existing registration for the mark "EPIC MMA" under Certificate of Registration No. 4-2013-002047 issued on 29 November 2013, even before the Opposer was granted registration for the mark "EPIC". In fact, the Opposer filed the application for the mark "EPIC" only on 11 December 2013 while the Respondent-Applicant filed the applications for the marks "EPIC MMA" and "EPIC MMA CLUB" on 22 February 2013. Also, none of the evidence the Opposer submitted shows that it has been appropriating the mark "EPIC" before the Respondent-Applicant filed the contested application. Therefore, even assuming that the marks are confusingly similar, the instant opposition must still fail.

Furthermore, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁶ Based on the above discussion, Respondent-Applicant's trademark sufficiently met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2013-002046 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 09 FEB 2017


Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

⁶ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.